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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,180	11/13/2003	Hidetada Nago	1232-5208	9816
27123	7590	08/30/2006	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			HOLLIDAY, JAIME MICHELE	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/713,180	NAGO, HIDETADA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jaime M. Holliday	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6, 12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 13, 14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

***Response to Arguments***

1. Applicant's arguments filed June 26, 2006 have been fully considered but they are not persuasive.

Applicant basically argues that Noda discloses that certain information is exchanged between an IC card before the wireless link may be established and not after the link is established. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., information exchanged after a link is established) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that Noda does not disclose anything relating to the wireless communication unit (20), which is alleged to correspond to the claimed "wireless communication apparatus." Examiner asserts that the action clearly stated on page 4 lines 5-6 that the IC card reads on the claimed "communication apparatus," and not as being argued by Applicant.

Applicant further argues that Noda fails to disclose a registration step and a reading step. Examiner respectfully disagrees, because Noda clearly shows and discloses that when the user places the IC card in proximity to the IC-card contactless communication unit of the personal computer, the IC-card contactless communication unit detects the IC card, and the IC-card contactless communication unit **records** the

local-network information required for the personal computer to form a wireless link with the personal computer in the IC card. When the user places the IC card in proximity to the IC-card contactless communication unit of the personal computer, the IC-card contactless communication unit detects the IC card, and determines whether local-network information is recorded in the IC card. If it is determined that local-network information is recorded in the IC card, the IC-card contactless communication unit **reads** the local-network information recorded in the IC card (see Office Action; pages 4-5).

In view of the above, the rejections using Noda are maintained as ~~re~~ected below. These rejections are made **FINAL**.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on June 26, 2006 and have been considered by the Examiner and made of record in the application file.
3. The information disclosure statement filed July 20, 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Examiner cannot interpret the document's relevance with an English translation. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining

compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-4, 7-10, 13, 16 and 17** are rejected under 35 U.S.C. 102(e) as being anticipated by **Noda (Pub # U.S. 2005/0015467 A1)**.

Consider **claims 1, 7 and 16**, Noda clearly shows and discloses communication apparatus and method that allow setting for forming a wireless link. A personal computer **1**, reading on the claimed “second communication apparatus,” includes a CPU (central processing unit) **11**, which is connected to an input/output interface **15** via a bus **14**, and furthermore, a ROM (read only memory) **12** and a RAM (random access memory) **13** are connected to the bus. An IC-card contactless communication unit **19** for detecting an IC card **2**, reading on the claimed “wireless communication apparatus having a wireless

communication unit and a memory," when it is placed in close proximity thereto and reading data from and writing data to the IC card, a wireless communication unit **20** for forming a wireless link and exchanging data with, for example, the access-point device **3**, by a wireless communication function conforming to IEEE 802.11b, according to access-point information, local-network information, or the like that is set by the CPU, (abstract, paragraphs 52-53). The personal computer **1-1**, reading on the claimed "second apparatus," starts processing when a user performs an operation for requesting that local-network information required for the personal computer **1-2**, reading on the claimed "first apparatus," to form a wireless link with the personal computer be recorded in the IC card. When the user places the IC card in proximity to the IC-card contactless communication unit **19-1** of the personal computer, the IC-card contactless communication unit detects the IC card, and the IC-card contactless communication unit records the local-network information required for the personal computer **1-2** to form a wireless link with the personal computer **1-1** in the IC card, reading on the claimed "registration step," (paragraphs 78 and 80). When the user places the IC card in proximity to the IC-card contactless communication unit **19-2** of the personal computer **1-2**, the IC-card contactless communication unit detects the IC card, and determines whether local-network information is recorded in the IC card. If it is determined that local-network information is recorded in the IC card, the IC-card contactless communication unit reads the local-network information recorded in the IC card, reading on the claimed "reading step." The CPU **11-2**

sets network configuration of the wireless communication unit **20-2** according to the local-network information read by the IC-card contactless communication unit, reading on the claimed "setting step." Thus, a wireless LAN is formed between the personal computer **1-1** and the personal computer **1-2** in ad-hoc mode, reading on the claimed "communication method for allowing a first apparatus to perform wireless communication by connecting said first apparatus to a wireless communication apparatus having a wireless communication unit and memory, said communication method comprising:

- a registration step registering, when said wireless communication apparatus is connected to a second apparatus, setting information for said first apparatus in said memory of said wireless communication apparatus by said second apparatus;

- a reading step of reading, when said wireless communication apparatus where the setting information has been registered at said registration step is connected to said first apparatus, the setting information from said memory of said wireless communication apparatus by said first apparatus; and

- a communication step of performing wireless communication by said wireless communication unit in accordance with the setting information set in said setting step, whereby the wireless communication by said first apparatus is achieved," (paragraphs 84 and 85).

Consider **claims 2 and 8**, and **as applied to claims 1 and 7**, respectively, Noda further discloses that the predetermined wireless communication standard

carried out by a first communication apparatus is IEEE 802.11b, reading on the claimed "the setting information includes information relating to a wireless LAN," (paragraphs 10 and 11).

Consider **claims 3 and 9**, and **as applied to claims 2 and 8**, respectively, Noda further discloses that the personal computer requires an SSID and a WEP KEY defined in IEEE 802.11b to be set before forming a wireless link with the access-point device, reading on the claimed "the setting information includes any of Service Set ID and Wireless Equivalent Privacy Key relating to wireless LAN communication," (abstract, paragraph 50).

Consider **claims 4 and 10**, and **as applied to claims 1 and 7**, respectively, Noda further discloses that the setting information may include at least one of ID information, a password associated with the ID information, a user name, and a password associated with the user name, reading on the claimed "the setting information includes identification information of said first apparatus," (paragraph 15).

Consider **claims 13 and 17**, Noda clearly shows and discloses communication apparatus and method that allow setting for forming a wireless link. A personal computer, reading on the claimed "second communication apparatus," includes a CPU (central processing unit), which is connected to an input/output interface via a bus, and furthermore, a ROM (read only memory) and a RAM (random access memory) are connected to the bus. An IC-card contactless communication unit for detecting an IC card, reading on the claimed



"communication apparatus," when it is placed in close proximity thereto and reading data from and writing data to the IC card, a wireless communication unit for forming a wireless link and exchanging data with, for example, the access-point device, reading on the claimed "first communication apparatus," by a wireless communication function conforming to IEEE 802.11b, according to access-point information, local-network information, or the like that is set by the CPU, (abstract, paragraphs 52-53). A first communication apparatus that includes wireless communication means for carrying out wireless communication with another electronic apparatus based on a predetermined wireless communication standard and reading means for reading the setting information, by contactless communication, from an information recording medium detected by a detection means. Since the access-point device is capable of writing data to the IC card, it is possible to additionally record user information for forming a link with a wireless LAN that is formed via the access-point device, (fig. 1, paragraphs 10 and 69). When the user places the IC card in proximity to the IC-card contactless communication unit **19-2** of the personal computer **1-2**, the IC-card contactless communication unit detects the IC card, and determines whether local-network information is recorded in the IC card. If it is determined that local-network information is recorded in the IC card, the IC-card contactless communication unit reads the local-network information recorded in the IC card. The CPU **11-2** sets network configuration of the wireless communication unit **20-2** according to the local-network information read by the IC-card contactless

communication unit. Thus, a wireless LAN is formed between the personal computer 1-1 and the personal computer 1-2 in ad-hoc mode, reading on the claimed "detection means for detecting a connection with said wireless communication apparatus;

reading means for reading setting information for said first apparatus registered in a memory of said communication apparatus by a second apparatus in accordance with the result of detection by said detection; and

setting means for setting the setting information read by said reading means in a wireless communication unit of said wireless communication apparatus as wireless communication parameters;

wherein said wireless communication apparatus performs wireless communication based on the setting information set in said wireless communication unit, whereby the wireless communication by said first apparatus is achieved," (paragraphs 84 and 85).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 5, 11 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Noda (Pub # U.S. 2005/0015467 A1)**, in view of **Sato (Pub # U.S. 2003/0009541 A1)**.

Consider **claims 5 and 11**, and as applied to **claims 1 and 10**, respectively, Noda clearly shows and discloses the claimed invention except that the setting information on the IC card is compared to information already stored on the second personal computer or access point.

In the same field of endeavor, Sato clearly shows and discloses a network system that comprises a target device to be managed that is connected to a network, and a management device that manages the target device, reading on the claimed "first and second communication devices," wherein the management device enables the target device to establish communications over the network and includes a first integrated circuit (IC) card drive in which an IC card stores communication parameters for enabling the management device to manage the target device, and wherein the target device includes a second IC card drive for reading the communication parameters stored in the IC card to set the

communication parameters that have been read. The network system uses the IC card as a relay to perform an initial setting of the communication parameters on the target device. This enables the communication parameters to be set only by insertion of the IC card into the target device, achieving a relatively easy setting operation, reading on the claimed "communication method and apparatus for connecting a communication apparatus to a first apparatus and performing communication, comprising: a registration step of connecting said communication apparatus to a second apparatus, and registering setting information for said first apparatus in said communication apparatus via said second apparatus," (paragraph 10). When a user of the management device **10** withdraws an IC card **50** from the IC card driver **20** of the management device, and carries and inserts the IC card into the IC card driver **70** of the network apparatus **60**, the controller **61** reads and sets some of the communication parameters stored in the IC card corresponding to the pertinent network apparatus. More specifically, the controller sets the communication parameters obtained through the IC card drive and the interface **66** on the storage part **65**. The controller is required to identify the communication parameters on the pertinent network apparatus among those stored in the IC card. For example, if user ID and password pairs are stored in the IC card, the controller may invite a user of the network apparatus to enter his/her user ID/password pair, and set the identified communication parameters, reading on the claimed "comparison step of comparing the identification information registered at said registration step with identification information of

said first apparatus previously set in said first apparatus, wherein said first apparatus controls performing the wireless communication in said communication step in accordance with the result of comparison at said comparison step," (paragraphs 71-75).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a step of verifying user ID and password as taught by Sato, in the system of Noda, in order to form a wireless link between two apparatuses in a wireless system.

Consider **claim 14**, and **as applied to claim 13 above**, Noda further discloses a first communication apparatus that includes wireless communication means for carrying out wireless communication with another electronic apparatus based on a predetermined wireless communication standard, reading means for reading the setting information, by contactless communication, from an information recording medium detected by a detection means, and setting means for adjusting setting of the wireless communication means according to the setting information read by the reading means, reading on the claimed "reading means reads the setting information," (fig. 1, paragraphs 10 and 69).

However, Noda fails to disclose that the setting information on the IC card is compared to information already stored on the second personal computer or access point.

In the same field of endeavor, Sato clearly shows and discloses a network system that comprises a target device to be managed that is connected to a

network, and a management device that manages the target device, reading on the claimed "first and second communication devices," wherein the management device enables the target device to establish communications over the network and includes a first integrated circuit (IC) card drive in which an IC card stores communication parameters for enabling the management device to manage the target device, and wherein the target device includes a second IC card drive for reading the communication parameters stored in the IC card to set the communication parameters that have been read. The network system uses the IC card as a relay to perform an initial setting of the communication parameters on the target device. This enables the communication parameters to be set only by insertion of the IC card into the target device, achieving a relatively easy setting operation, reading on the claimed "communication method and apparatus for connecting a communication apparatus to a first apparatus and performing communication, comprising: a registration step of connecting said communication apparatus to a second apparatus, and registering setting information for said first apparatus in said communication apparatus via said second apparatus," (paragraph 10). When a user of the management device withdraws an IC card from the IC card driver of the management device, and carries and inserts the IC card into the IC card driver of the network apparatus, the controller reads and sets some of the communication parameters stored in the IC card corresponding to the pertinent network apparatus. More specifically, the controller sets the communication parameters obtained through the IC card drive and the interface

on the storage part. The controller is required to identify the communication parameters on the pertinent network apparatus among those stored in the IC card. For example, if user ID and password pairs are stored in the IC card, the controller may invite a user of the network apparatus to enter his/her user ID/password pair, and set the identified communication parameters, reading on the claimed "second reading means for reading the identification information from said wireless communication apparatus; and comparison step of comparing the identification information registered at said registration step with identification information of said first apparatus previously set in said first apparatus, wherein at said establishment step, the communication is established in accordance with the result of comparison at said comparison step," (paragraphs 71-75).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a step of verifying user ID and password as taught by Sato, in the system of Noda, in order to form a wireless link between two apparatuses in a wireless system.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime M. Holliday whose telephone number is (571) 272-8618. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

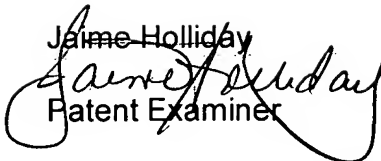
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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CHARLES APPIAH  
PRIMARY EXAMINER

Jaime Holliday  
  
Patent Examiner